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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/935,936
	Filing Date	August 23, 2001
	First Named Inventor	Donald Gilbert Carpenter
	Art Unit	2834
	Examiner Name	N. Ponomarenko
	Attorney Docket Number	21,001
Total Number of Pages in This Submission <i>118</i>		

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
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<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	Remarks	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Request for Reinstatement of Appeal; Supplemental Appeal Brief (in triplicate); Return Postal Card; AND TRANSMITTAL LETTER	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	John P. Sinnott
Signature	<i>John P. Sinnott</i>
Date	June 29, 2004

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Donald Gilbert Carpenter **Examiner:** N. Ponomarenko  
**Serial No.:** 09/935,936  
**Filing Date:** August 23, 2001 **Art Unit:** 2834  
**For:** Energy Conversion Technique

**EXPRESS MAIL CERTIFICATE**

**Express Mail Label No.:** <sup>ED</sup> **ER 061030425 US**

**Date of Deposit:** June 29, 2004

I hereby certify that the following attached paper(s) and/or fee(s)

1. Certificate of Express Mailing;
2. Supplemental Appeal Brief Under 37 CFR §1.193(b)(2)(ii) (in triplicate);
3. Request for Reinstatement of Appeal Under 37 CFR §1.193(b)(2)(ii); and
4. Return Postcard

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. '1.10 on the date indicated above and is addressed to Honorable Commissioner of Patents; P.O. Box 1450; Alexandria, VA 22313-1450.

**JOHN P. SINNOTT**

(Typed or printed name of person mailing paper(s) and/or fee)

(Signature of person mailing paper(s) and/or fee)

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ED 061030425 US



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** DONALD GILBERT CARPENTER

**Art Unit:** 2834

**Serial No.:** 09/935,936

**Filed:** August 23, 2001

**For:** Energy Conversion Technique

**Examiner:** Nicolas Ponomarenko

**SUPPLEMENTAL APPEAL BRIEF UNDER 37 CFR §1.193(b)(2)(ii) (in triplicate)**

Honorable Commissioner of Patents  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith, in triplicate, is applicant's Supplemental Appeal Brief Under 37 CFR §1.193(b)(2)(ii).

It is applicant's position that the attempt to reopen prosecution of this application under 37 CFR §1.118 "Request for Continued Examination" stated in the June 7, 2004, "Communication Re: Appeal," is a nullity for the reasons of record in this matter. Briefly, however, Rule 114 applies only to those cases in which an applicant requests continued examination of an application after prosecution is closed.

Prosecution of this case was closed in the July 24, 2003, Final Rejection of all claims standing in the case.

Applicant, however, has not lodge a request for continued examination.

Consequently, an *ex parte* attempt to reopen examination of this application in the absence of an applicant lodged request for continued examination is beyond the terms of Rule 114 and necessarily must fail.

Consequently, this application continues under appeal.

Notwithstanding the nullity of the effort to reopen prosecution of this case, 37 CFR §1.193 "Examiner's answer and reply brief" has been cited. Accordingly, for completeness' sake, applicant addresses those parts of Rule 193 that are relevant to this matter.

For example, 37 CFR §1.193(a)(2) requires the examiner to file a written answer to the Appeal Brief filed January 7, 2004. Applicant respectfully requests receipt of the examiner's answer.

Turning now to 37 CFR §1.193(a)(2), it is clear that the examiner's answer must not include a new ground of rejection. Consequently, the record before the Board of Patent Appeals and Interferences with respect to the appealed subject matter was closed on July 24, 2003, the Final Rejection mailing date. In this circumstance, it would not be possible to impose a further evidentiary requirement on applicant, e.g. a "working model" and still remain within the legal ambit of 37 CFR §1.193(a)(2).

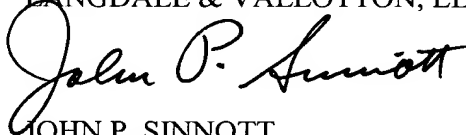
As advanced in several instances in the record of this case as it stands before the Board of Patent Appeals and Interferences, the purported reopening of examination is a nullity. But to establish a complete response to all of the issues raised in the June 7, 2004, "Communication Re: Appeal", attention now is invited to 37 CFR §1.193(b)(2)(ii) which addresses those actions that applicant must take to perfect a request for reinstatement of the appeal.

Thus, in keeping with 37 CFR §1.193(b)(2)(ii), herewith, in triplicate, is submitted the required supplemental appeal brief. Further, this provision in the Rule prohibits applicant from submitting new evidence in this matter. As a result, it is not possible for applicant to comply with the requirement in the June 7, 2004, "Communication Re: Appeal" to supply a "working model" of the invention without violating 37 CFR §1.193(b)(2)(ii).

In summary, applicant earnestly solicits the Board of Patent Appeals and Interferences to treat the purported action under 37 CFR §1.114 to reopen prosecution as a nullity and to continue this application in its appealed status. Further, applicant requests timely receipt of an examiner's answer in the form required under the terms of 37 CFR §1.193(a).

Respectfully submitted

LANGDALE & VALLOTTON, LLP



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Donald Gilbert Carpenter      **Art Unit:** 2834  
**Serial No.:** 09/935,936  
**Filed:** August 23, 2001  
**For:** Energy Conversion Technique      **Examiner:** Nicolas Ponomarenko

**Request for Reinstatement of Appeal Under 37 CFR §1.193(b)(2)(ii)**

Honorable Commissioner of Patents  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

On June 7, 2004, a Communication with respect to the appeal filed in connection with the above-identified patent application was mailed from the Patent and Trademark Office to undersigned counsel.

The June 7, 2004, Communication purports to:

1. Reopen prosecution "...pursuant to 37 CFR 1.114." (Communication regarding appeal, Page 1, 4.(c)); and
2. Dismiss the appeal as not fully responsive to the final office action.

I. Reliance on 37 CFR 1.114 to "Reopen" Prosecution

A copy of 37 CFR §1.114 "Request for Continued Examination" is attached (Exhibit A).

This regulation applies only to those applications in which:

1. Prosecution is closed (e.g. under appeal or final action); and
2. Subject to a request for continued examination.

Applicant has not lodged a request for continued examination of this application.

Nowhere in 37 CFR §1.114 is there even a suggestion that an examiner can withdraw an application from appeal and reopen prosecution in the absence of an applicant filed request for continued examination. With respect to the application under consideration, the purported action by the examiner to dismiss the appeal and reopen prosecution *sua sponte* is entirely beyond any possible interpretation of Section 1.114.

In this circumstance, applicant submits that this case is not before the examiner, but remains under appeal. Accordingly, applicant respectfully requests that:

1. The Office asserts that the alleged status of this application as being before the examiner is a nullity;
2. The Office confirm the appellate status of this case; and
3. Provide applicant with an examiner's answer to the Appeal Brief filed January 7, 2004, as required under 37 CFR §1.193 (Exhibit B).

II. Dismissal of appeal as not fully responsive to the Final Office Action

The failed attempt to reopen prosecution of this case under 37 CFR §1.114 for the reasons advanced in I, above, should be dispositive of all issues raised in the June 7 Communication. For completeness' sake, however, the positions taken in the June 7, 2004, "Communication Re: Appeal" with respect to 37 CFR §1.193 and 37 CFR §1.91 (2)[sic] and (b) (Exhibit C) nevertheless are analyzed.

As stated in the June 7 Communication:

Applicant(s) are required to furnish a working model of the claimed invention per 37 CFR 1.91(2) [sic] and (b) since it is deemed necessary [sic] for examination of the application.

Please note in the attached copy of 37 CFR §1.91 "Models or exhibits not generally admitted as part of application or patent" that there is no Section 1.91(2).

With respect to Section 1.91(b), however, the specific wording of this passage is relevant to the status of the application, thus:

...a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in *examination* of the application. [Emphasis supplied.]

Consequently, an application must be under examination in order to properly lodge a demand that applicant furnish a working model.

Having finally rejected all eight claims in this case in the July 24, 2003 Official Action and a Notice of Appeal having been lodged on October 2, 2004, applicant respectfully submits that prosecution is closed and the application is under appeal and not under examination. In this instance, the only recourse permitted under the Rules of Practice are defined in 37 CFR §1.193 "Examiner's answer and reply brief." Accordingly, please note Section 1.193(a)(2) which states, in part:

An examiner's answer must not include a new ground of rejection....

Considering now the following passage quoted from the final rejection of July 24, 2003, (Exhibit D):

Claims 1-8 are rejected under 35 USC §101 because the disclosed invention is inoperative and therefore lacks utility. The disclosed invention is inoperative because it contradicts the doctrine of conservation of energy.

As developed in detail in applicant's Appeal Brief, the Manual of Patent Examining Procedure (MPEP) §608.03 (Exhibit E), which was cited to support the final rejection, states:

...If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he or she may choose his or her own way of so doing.

"Operativeness" was questioned and applicant exercised his right to prove "operativeness" under MPEP §608.3 by a timely filed Rule 132 Declaration.

"Perpetual Motion" was not the ground for rejecting the instant application. Of particular importance is the rejection in the Official Action dated November 7, 2002, repeated again in the July 24, 2003, Final Rejection, in which all eight claims were dismissed on the ground of "operativeness"

In contrast, however, the Communication under consideration attempts to assert "perpetual motion" as a new ground of rejection. This assertion of a new rejection ground not only violates the passage in Section 1.193(a)(2) quoted above, but the further "requirement" to provide a "working model" also contradicts the express provisions of MPEP §608.03.

The Communication in question, moreover, does further violence to Section 1.193. In this respect, attention now is invited to Section 1.193(b)(2) which, in part, states:

Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

....  
(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief [submitted herewith], but no new amendments, affidavits (§§1.130, 1.131 or 1.132) or *other evidence* are permitted [emphasis applied].



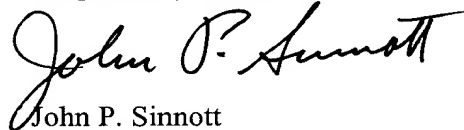
Thus, assuming *arguendo* that the appeal is properly dismissed, applicant, in submitting this Request for Reinstatement is prohibited by the Rules of Practice from supplying the requested working model of the invention!

In summary:

1. Because applicant has not filed a request for continued examination of this application, the purported dismissal of the appeal and reopening of prosecution in the June 7, 2004, "Communication Re: Appeal" under 37 CFR §1.114 is a nullity;
2. Application continues in appeal and applicant respectfully requests issuance of an examiner's answer, as required under 37 CFR §1.193;
3. The request for a working model of the claimed invention in the failed effort to reopen prosecution not only contravenes the express terms of MPEP §608.03, but also requires applicant to submit new evidence in clear violation of 37 CFR §1.193(b)(2)(ii).

Accordingly, applicant earnestly solicits confirmation that this case is under appeal; issuance of an examiner's answer and withdrawal of the working model requirement.

Respectfully submitted,



John P. Sinnott  
Attorney for Appellant  
Registration No. 21,001

JPS/vi



claim (§1.181). Reply to a final rejection or action must comply with §1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under §1.913, see §1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[65 FR 14872, Mar. 20, 2000, as amended at 65 FR 76773, Dec. 7, 2000]

#### **§1.114 Request for continued examination.**

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in §1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under §1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§1.113), a notice of allowance (§1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of §1.111.

(d) If an applicant timely files a submission and fee set forth in §1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under §1.192 or a reply brief under §1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

(1) A provisional application;



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(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;

(4) An application for a design patent; or

(5) A patent under reexamination.

[65 FR 50104, Aug. 16, 2000]

## Amendments

Authority: Secs. 1.115 to 1.127 also issued under 35 U.S.C. 132.

### §1.115 Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§1.6) on or before the mail date of the first Office action under §1.104.

(b) (1) A preliminary amendment will be entered unless disapproved by the Commissioner. A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(i) The state of preparation of a first Office action as of the date of receipt (§1.6) of the preliminary amendment by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(2) A preliminary amendment will not be disapproved if it is filed no later than:

(i) Three months from the filing date of an application under §1.53(b);

(ii) The filing date of a continued prosecution application under §1.53(d); or

(iii) Three months from the date the national stage is entered as set forth in §1.491 in an international application.

(c) The time periods specified in paragraph (b)(2) of this section are not extendable.

[65 FR 54672, Sept. 8, 2000]



(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8) (i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(9) *Appendix.* An appendix containing a copy of the claims involved in the appeal.

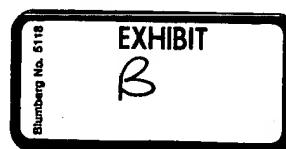
(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed. (35 U.S.C. 6, Pub. L. 97-247; 15 U.S.C. 1113, 1123)

[36 FR 5850, Mar. 30, 1971, as amended at 53 FR 23734, June 23, 1988; 58 FR 54510, Oct. 22, 1993; 60 FR 14518, Mar. 17, 1995; 62 FR 53196, Oct. 10, 1997]

### **§1.193 Examiner's answer and reply brief.**

(a) (1) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under §1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under §1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under §1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under §1.116 as appellant was so advised. The filing of an amendment under §1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s)



added or amended by the amendment under §1.116 subject to any rejection set forth in the action from which the appeal was taken.

- (b) (1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See §1.136(b) for extensions of time for filing a reply brief in a patent application and §1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under §1.111, if the Office action is not final, or a reply under §1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§1.130, 1.131 or 1.132) or other evidence are permitted.

[62 FR 53197, Oct. 10, 1997, as amended at 65 FR 54676, Sept. 8, 2000]

#### **§1.194 Oral hearing.**

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in §1.17(d) within two months from the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in §1.17(d), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See §1.136(b) for extensions of time for requesting an oral hearing in a patent application and §1.550(c) for extensions of time for requesting an oral hearing in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by appellant, the appeal will be assigned for consideration and decision. If appellant has requested an oral hearing and has submitted the fee set forth in §1.17(d), a day of hearing will be set, and due notice thereof given to appellant and to the primary examiner. A hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for appellant and fifteen minutes for the primary



or formal drawing in compliance with §1.84 to avoid abandonment. This time period is not extendable under §1.136(a) or §1.136(b).

[65 FR 54670, Sept. 8, 2000, as amended at 65 FR 57055, Sept. 20, 2000]

**§1.88 [Reserved]**

**Models, Exhibits, Specimens**

**Authority:** Secs. 1.91 to 1.95 also issued under 35 U.S.C. 114.

**§1.91 Models or exhibits not generally admitted as part of application or patent.**

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

(1) Substantially conforms to the requirements of §1.52 or §1.84;

(2) Is specifically required by the Office; or

(3) Is filed with a petition under this section including:

(i) The fee set forth in §1.17(h); and

(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

[62 FR 53190, Oct. 10, 1997, as amended at 65 FR 54670, Sept. 8, 2000]

**§1.92 [Reserved]**

**§1.93 Specimens.**

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

**§1.94 Return of models, exhibits or specimens.**

Models, exhibits, or specimens in applications which have become abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and



Art Unit: 2834



## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

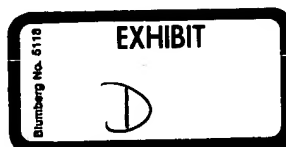
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

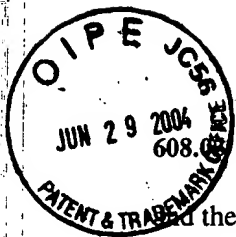
2. **Claims 1 - 8** are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The disclosed invention is inoperative because it contradicts the doctrine or principle of conservation of energy.

#### ***Doctrine or principle of the conservation of energy.***

If the boundary considered includes the universe, the principle of the conservation of energy amounts to a statement that the sum total of the energy of the universe is a fixed unalterable quantity.

The principle of the conservation of energy also denies the possibility of "perpetual motion." By "perpetual motion" is meant the devising of some arrangement so that energy in one form can be produced without energy in some other form being used up by the machine. Thus if an engine could be made to do work on external bodies for an indefinite time, and thus give out energy, without being supplied with energy from without, or diminishing the stock of energy in all its various forms which it originally possessed, we should have a means of creating energy, and this is in direct contradiction to the principle of the conservation of energy.





## MANUAL OF PATENT EXAMINING PROCEDURE

and the Notice of Allowability was mailed prior to the receipt of the substitute drawings, the technical support staff should forward the substitute drawings to the Publishing Division. Submission to the examiner is not necessary unless an amendment accompanies the drawings which changes the specification, such as where the description of figures is added or canceled.

### BORROWING FILES FROM PUBLISHING DIVISION

Allowed files requiring drawing corrections are sent to the Publishing Division. At times, examiners have a need to borrow these applications. When borrowing applications, examining corps personnel must submit a request to the Office of Patent Publications Customer Service Center.

### 37 CFR 1.312 AMENDMENTS

In handling 37 CFR 1.312 amendments, the examining corps should process drawings canceled in the normal manner. If there are corrections to the drawing, approval, if appropriate, is indicated by the examiner on form PTOL-271 in conjunction with form paragraph 6.48; the paragraph sets the appropriate period for effecting the approved drawing change.

#### ¶ 6.48 Drawing Changes in 37 CFR 1.312 Amendment

Applicant is hereby given **ONE MONTH** from the mailing date of this letter or until the expiration of the period set in the "Notice of Allowance" (PTOL-85) or "Notice of Allowability" (PTOL-37 or PTO-37), whichever is longer, to file corrected drawings.

#### Examiner Note:

Use with the 37 CFR 1.312 amendment notice where there is a drawing correction proposal or request.

### 608.03 Models, Exhibits, Specimens

#### 35 U.S.C. 114. Models, specimens.

The Director may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Director may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

#### 37 CFR 1.91. Models or exhibits not generally admitted as part of application or patent.

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

(1) Substantially conforms to the requirements of § 1.52 or § 1.84;

(2) Is specifically required by the Office; or

(3) Is filed with a petition under this section including:

(i) The fee set forth in § 1.17(h); and

(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

Models or exhibits are generally not admitted as part of an application or patent unless the requirements of 37 CFR 1.91 are satisfied.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he or she may choose his or her own way of so doing.

A physical exhibit, not to be part of the application, is generally not refused except when bulky or dangerous. Such exhibit, if left with the examiner, may be disposed of at the discretion of the Office.

#### 37 CFR 1.93. Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

See MPEP Chapter 2400 regarding treatment of biotechnology deposits.

### 608.03(a) Handling of Models, Exhibits, and Specimens

All models and exhibits received in the U.S. Patent and Trademark Office should be taken to the Technology Center (TC) assigned the related application for examination. The receipt of all models and exhibits which are to be entered into the application file record must be properly recorded on the "Contents" portion of the application file wrapper.

A label indicating the application number, filing date, and attorney's name and address should be attached to the model or exhibit so that it is clearly identified and easily returned after prosecution of the application is closed, if return is requested and the model or exhibit is deemed not necessary for the examination of the application. See 37 CFR 1.94.

